

Attorney Docket No. AUS920030365US1
Serial No. 10/626,194
Appeal Brief

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Fellenstein) Serial No. 10/626,194
)
 Applicant,) Docket No. AUS920030365US1
)
 For: Method and System for Identification and) Art Unit 2109
 Presentation of Statistical Usage Data for)
 Messaging Systems)
)
 Filed: 07/24/2003) Examiner Fearer
)

AMENDED APPEAL BRIEF

February 15, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

To the Honorable Commissioner of Patents:

The examiner of the pending application identified above finally rejected the applicant's claims set forth herein, and the appellant timely submitted a Notice of Appeal to the Board of Patent Appeals and Interferences. The Notice of Appeal was submitted on August 2, 2007 along with a Pre-Appeal Brief Request for Review Statement. On November 15, 2007 the Notice of Panel Decision from Pre-Appeal Brief Review was mailed. Applicant filed this Appeal Brief in accordance with the Notice of Panel Decision from Pre-Appeal Brief Review.

Attorney Docket No. AUS920030365US1
Serial No. 10/626,194
Appeal Brief

TABLE OF CONTENTS

I. REAL PARTY INTEREST.....	3
II. RELATED APPEALS AND INTERFERENCES	3
III. STATUS OF THE CLAIMS.....	3
IV. STATUS OF THE AMENDMENTS.....	5
V. SUMMARY OF THE CLAIMED SUBJECT MATTER.....	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	6
VII. ARGUMENT.....	7

I. REAL PARTY INTEREST

The real party in interest in the present application is International Business Machines Corporation.

II. RELATED APPEALS AND INTERFERENCES

Neither the applicants, the applicant's legal representative, nor the assignee has any knowledge of any application, patent, appeal, interference, or judicial proceeding which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

The application included 27 claims. Claims 1-27 are pending. No claims have been allowed. The examiner has rejected all pending claims. Claims 1 through 27 are appealed.

Claim	Type	Depends from	Status	Appealed
1	Independent		Rejected	Yes
2	Dependent	1	Rejected	Yes
3	Dependent	1	Rejected	Yes
4	Dependent	1	Rejected	Yes
5	Dependent	1	Rejected	Yes
6	Dependent	1	Rejected	Yes
7	Dependent	6	Rejected	Yes
8	Dependent	1	Rejected	Yes

Attorney Docket No. AUS920030365US1

Serial No. 10/626,194

Appeal Brief

9	Dependent	8	Rejected	Yes
10	Dependent	1	Rejected	Yes
11	Independent		Rejected	Yes
12	Dependent	11	Rejected	Yes
13	Dependent	11	Rejected	Yes
14	Dependent	11	Rejected	Yes
15	Dependent	11	Rejected	Yes
16	Dependent	11	Rejected	Yes
17	Dependent	16	Rejected	Yes
18	Dependent	11	Rejected	Yes
19	Dependent	18	Rejected	Yes
20	Dependent	11	Rejected	Yes
21	Independent		Rejected	Yes
22	Dependent	21	Rejected	Yes
23	Dependent	21	Rejected	Yes
24	Dependent	21	Rejected	Yes
25	Dependent	21	Rejected	Yes
26	Dependent	21	Rejected	Yes
27	Dependent	21	Rejected	Yes

IV. STATUS OF THE AMENDMENTS

Amendments to claims 1, 11, and 21 submitted on April 19, 2007 have been entered. The remaining claims are original claims. There are no un-entered amendments.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1

Claim 1 is to a programmable apparatus for identifying optimal times for an end user to contact a target user of a messaging system (Specification 6:1-7:20). The programmable apparatus comprises: an event monitor to detect messaging system events and to record the messaging system events in a database (Specification 3:7; 7:21-9:4); a usage processor to compile statistical usage data from the events in the database (Specification 3:8; 9:5-10:8); and a usage indicator to display the target user's statistical usage data on an output device (Specification 3:8; 9:5-10:8). The statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received (Specification 8:14-23; 9:23-10:2).

Claim 11

Claim 11 is for a computer readable memory for causing a computer to identifying optimal times for an end user to contact a target user of a messaging system (Specification 7:1-20). The computer readable memory comprises a computer readable storage medium (Specification 7:6-9); a computer program stored in the storage medium (Specification 7:6-9) so configured by the computer program, that it causes the computer to detect messaging system events; record the

messaging system events in a database (Specification 3:7; 7:21-9:4); compile the target user's statistical usage data from the messaging system events in the database (Specification 8:14-9:4; 9:21-10:4); and display the target user's statistical usage data on an output device (Specification 10:4-5). The statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received (Specification 8:14-23; 9:23-10:2).

Claim 21

Claim 21 is to a method of identifying optimal times for an end user to contact a target user of a messaging system (Specification 7:1-20). The method comprises detecting messaging system events (Specification 7:23-8:3), recording the messaging system events in a database (Specification 8:11-12), compiling statistical usage data from the messaging system events (Specification 8:14-9:4; 9:21-10:4), and displaying the target user's statistical usage data on an output device (Specification 10:4-5). The statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received (Specification 8:14-23; 9:23-10:2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-10, 11-20 and 21-27 are unpatentable under 35 USC 103(a) over Matsliach et al. (US Patent 6,879,994) in view of Monza et al. (US 20040081183A1) and in further view of Tamir et al. (US 6957390)

The limitations to be argued are the same for independent claims 1, 11, and 21. Claim 1 is representative of the independent claims. Dependent claims 2-10 stand or fall with claim 1. Dependent claims 12-20 stand or fall with claim 11. Dependent claims 22-27 stand or fall with claim 21. Therefore, claim 1 is representative of the claims.

VII. ARGUMENT

A. Applicable law

An applicant's claimed invention may be unpatentable under 35 U.S.C. § 103 if it would have been "obvious" to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. *See* 35 U.S.C.S. § 103(a); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (stating that "obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention," even if the prior art does not "reach expressly each limitation exactly"); *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) ("the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). "Obviousness" is a legal conclusion based on underlying findings of fact.¹ *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining "the scope and content of the prior art;" ascertaining the "differences between the prior art and the claims at issue;" and resolving "the level of ordinary skill in the pertinent art." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

¹ Legal conclusions of obviousness are reviewed *de novo*, while the underlying factual conclusions are reviewed for substantial evidence. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003).

The examiner, though, carries the initial burden of establishing a *prima facie* case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Wertheim*, 541 F.2d 257, 263 & 265 (C.C.P.A. 1976); MPEP § 2141, 2142, 706.02(j); see also 35 U.S.C.S. § 132. To establish *prima facie* obviousness of a claimed invention, the examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. See, e.g., *In re Zurko*, 258 F.3d at 1384-85 (holding invention was not obvious because prior art failed to teach single element); *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1986) (finding that prior art was deficient in at least one element – the claimed invention could not have been obvious without motivation to add element); accord MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

B. Claims 1-10

Claims 9-10 depend from Independent Claim 1 and stand or fall with claim 1. Claim 1 is patentable over the cited art for the following reasons.

1. The cited art does not disclose the limitation “detect messaging system events.” The examiner cited Matsliach col. 13 lines 45-52 which states the following:

Upon detection of a new user event, process 71 continues from step 76 to step 80 wherein user computer 14 determines what type of user event has occurred. If the user has asked to change his/her user profile, process 71 continues to step 80a. The updated information is input and then transmitted to server 10 (step 80a-1). Then the information is stored both locally on user computer 14 and in a user database of server 10 (step 80a-2), after which process 71 returns to step 76.

Matsliach discloses events, but does not disclose the events as set forth in the claim. Reading the term events as it is used in the claim, the events must include data from which statistical usage data regarding an end user may be compiled. The claim further requires that the event data include a “plurality of data regarding the target user’s times for signing in and signing out, the

target user's average time signed on each day, and the target user's messages sent and received."

Matsliach does not disclose such events.

2. The cited are does not disclose the limitation "record the messaging system events in a database." The examiner also cited *Matsliach* col. 13 lines 45-52 for this limitation. But *Matsliach* does not disclose the events identified in the claim. Moreover, *Matsliach* does not disclose recording such events inn a database. Further , *Matsliach* does not disclose recording data regarding an end user in a database. Applicant submits that the claim terms must be construed as they are used in the claim. The examiner has taken terms individually to give them their broadest interpretation, but such interpretation is improper when the interpretation is inconsistent with the terms usage in the entire claim.

3. The limitation "a usage processor to compile the target user's statistical usage data from the messaging system events in the database." The examiner cited *Matsliach* col. 3, lines 40-43 which states the following:

The information is processed to determine the current "hot" Internet sites or pages at or near real-time, the popular sites on a historical basis, i.e., over the past N days or hours, various usage trends, etc.

Matsliach teaches determining whether an Internet site is being accessed. Though it is difficult to tell, the Examiner appears to read the claim's "events" onto *Matsliach*'s "information." Applicant respectfully disagrees because the claim's antecedent basis for "events" is the phrase "messaging system events," whereas *Matsliach*'s "information" is determined from the duration of time a user spends at a web page. See *Matsliach* col. 3, ll. 23-34.

4. The limitation "display the target user's statistical usage data on an output device." The examiner cited *Matsliach* col. 3, lines 43-46 which states "[t]his information can be presented to users in the form of, e.g., a histogram displayed on the user's screen, and integrated

with link maps, directory information, and other navigation tools.” As explained above, Matsliach is referring to access data for an Internet site, and does not disclose statistical usage data regarding a “target user.”

5. The cited art does not disclose the limitation “wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user’s times for signing in and signing out, the target user’s average time signed on each day, and the target user’s messages sent and received.” The Examiner admits *Matsliach* fails to teach these limitations and alleges *Monza* discloses these limitations. *Monza* teaches storing statistical data regarding hit and miss rates of contacts and further teaches learning which are the best contact media types and the best times to initiate contacts. *Monza* para. [0068]. In other words, *Monza* teaches its statistical data is used to allow the system to learn the best times to initiate contacts, whereas the claim recites “the statistical usage data is adapted to allow the end user to determine a best time to contact the target user.” Hence, instead of providing information to allow an end user to determine the best time to contact a target user, *Monza* teaches a system that determines a best time to send messages from the system to a contact. The Examiner appears to interpret *Monza*’s data regarding hit and miss rates of contacts as meeting the claim’s “data regarding … target user’s messages sent and received.” Applicant respectfully disagrees with this interpretation because the hit and miss rates of contacts are not an equivalent of a “target user’s messages sent and received.” Specifically, *Monza*’s contacts are outbound contacts. See *Monza* para. [0068]. In other words, *Monza*’s messages are from the system to the contact, yet it is silent to its hit and miss rates being related to messages from the contacts. Hence, the cited art fails to teach “target user’s messages sent and received.”

Specifically, the examiner cited Monza paragraph 0068 which states the following:

Part of PE component within engine 112 is a self-learning component. The self-learning component enables proactive outbound contacts to be initiated using the most optimum media type and contact parameters to ensure the best chance for success of contact and probable response. For example, if a client like a business partner repeatedly does business with enter 104 then all of his or her available media types, contact parameters, preferences, rules for etiquette, and normal itinerary, are stored in HDM within facility 114. Also stored in HDM under the same client ID parameters are statistical data regarding hit and miss rates of previous proactive outbound contacts and the result data of those contacts over an extended period of history. Over time, the system “learns” what the most successful proactive contact media types are and when the best times are to initiate the contacts. As more data is compiled more intelligence is gleaned.

The examiner further cited Monza paragraph 0160 which states the following:

At step 503, if the media type of the interaction is live voice, interactive text-based, or asynchronous messaging, the interaction content and any results are stored at step 504. At step 505 the business process ensues, meaning that interaction is still ongoing and the purpose of the client has yet to be satisfied. It is noted herein that further routing, re-direction, transfers, and other steps may be part of the process. Further, the entire interaction chain is captured and recorded as it occurs. It is further noted that the end of a process does not necessarily mean the closing interaction of a transaction. The definition of process may include, for example, post-closing operations that still need to be performed.

The examiner stated that “...it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate a self learning multimedia communications environment as taught by Monza, with a system for processing and presenting internet usage information to facilitate user communications as taught by Matsliach for the purpose of tagging customer preferences.” Claim 1 does not describe a self learning multimedia communications environment and claim 1 does describe “tagging customer preferences.”

The examiner stated that Matsliach, as modified by Monza et. al., fails to teach recording times that users log in and out of the system or the average time of a logged in session. The examiner cited Tamir col. 9, lines 13-23 which states the following:

Using the Session Start 304 and Session End 306, the server system can also determine what times the user and application began and completed the client-server session. The server system can thereby determine user-specific statistics including the user session duration and peak time of use, as well as client-specific statistics including client session duration and peak-time of use. The server system can also determine system-wide user and client statistics including the average user session duration, average client session duration, user session peak time, and client session peak time of use.

Claim 1 recites “a plurality of data regarding the target user’s times for signing in and signing out, the target user’s average time signed on each day, and the target user’s messages sent and received.” Claim 1 is directed to data for a messaging system. Claim 1 is not directed to “users” but to data regarding “target users” as opposed to “end users.” Tamir is not directed to a messaging system.

C. Claims 11-20

Claims 11-20 are directed to a computer readable memory, but independent Claim 11 includes all of the limitations discussed above for claim 1. Therefore, applicant submits that claim 1 is representative of claim 11. Claims 12-20 stand or fall with claim 11.

D. Claims 21-27

Claims 21-27 are directed to a method. Independent claim 21 includes the same limitations discussed above in regard to Claim 1. Therefore, applicant submits that claim 1 is representative of claim 21. Claims 22-27 stand or fall with claim 21.

Attorney Docket No. AUS920030365US1
Serial No. 10/626,194
Appeal Brief

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CLAIMS APPENDIX

Please amend the claims as indicated in the following listing:

1. A programmable apparatus for identifying optimal times for an end user to contact a target user of a messaging system, comprising:
 - an event monitor to detect messaging system events and to record the messaging system events in a database;
 - a usage processor to compile statistical usage data from the events in the database; and
 - a usage indicator to display the target user's statistical usage data on an output device;

wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received.
2. The apparatus of claim 1, wherein the messaging system is an instant messaging system.
3. The apparatus of claim 1, wherein the messaging system is an email messaging system.
4. The apparatus of claim 1, wherein the messaging system is an electronic bulletin board system.
5. The apparatus of claim 1, wherein the event monitor allows the target user to disable the recording of the target user's events.
6. The apparatus of claim 1 further comprising a watch list.
7. The apparatus of claim 6, wherein the event monitor only records events matching a type included in the watch list.
8. The apparatus of claim 1 further comprising an access list for the target user.

9. The apparatus of claim 8, wherein the usage processor compiles the target user's statistical usage data only if the end user is in the target user's access list.
10. The apparatus of claim 1, wherein the usage indicator saves the target user's statistical usage data in a summary file.
11. A computer readable memory for causing a computer to identify optimal times for an end user to contact a target user of a messaging system, comprising:
 - a computer readable storage medium;
 - a computer program stored in the storage medium, wherein the storage medium, so configured by the computer program, causes the computer to detect messaging system events;
 - record the messaging system events in a database;
 - compile the target user's statistical usage data from the messaging system events in the database; and
 - display the target user's statistical usage data on an output device;wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received.
12. The computer readable memory of claim 11, wherein the messaging system is an instant messaging system.
13. The computer readable memory of claim 11, wherein the messaging system is an email messaging system.

14. The computer readable memory of claim 11, wherein the messaging system is an electronic bulletin board system.
15. The computer readable memory of claim 11, wherein the computer program causes the computer to allow the target user to disable the recording of their own events.
16. The computer readable memory of claim 11 further comprising a watch list stored in the computer readable storage medium.
17. The computer readable memory of claim 16, wherein the computer program causes the computer to record only events matching a type included in the watch list.
18. The computer readable memory of claim 11 further comprising an access list for the target user, the access list being stored in the computer readable storage medium.
19. The computer readable memory of claim 18, wherein the computer program causes the computer to compile the target user's statistical usage data if the end user is in the target user's access list.
20. The computer readable memory of claim 11, wherein the computer program causes the computer to save the target user's statistical usage data in a summary file.
21. A method of identifying optimal times for an end user to contact a target user of a messaging system, comprising detecting messaging system events, recording the messaging system events in a database, compiling statistical usage data from the messaging system events, and displaying the target user's statistical usage data on an output device; wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received.

22. The method of claim 21, wherein the messaging system is an instant messaging system.
23. The method of claim 21, wherein the messaging system is an email messaging system.
24. The method of claim 21, wherein the messaging system is an electronic bulletin board system.
25. The method of claim 21, wherein the steps following the detecting step do not occur if the target user has disabled the recording of the target user's events.
26. The method of claim 21, wherein the recording step only records events matching a type included in a watch list.
27. The method of claim 21, wherein the compiling step only occurs if the end user is included in a target user's access list.

Attorney Docket No. AUS920030365US1
Serial No. 10/626,194
Appeal Brief

EVIDENCE APPENDIX

NONE

Attorney Docket No. AUS920030365US1
Serial No. 10/626,194
Appeal Brief

RELATED PROCEEDINGS APPENDIX

NONE